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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/146,069	09/02/1998	TAKEHIRO YOSHIDA	1232-4467	6726

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EXAMINER	
POKRZYWA, JOSEPH R	

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/146,069	YOSHIDA, TAKEHIRO	
	Examiner	Art Unit	
	Joseph R. Pokrzywa	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 October 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-16,18-20 and 22-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-16,18-20 and 22-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 11/13/03, and has been entered and made of record. Currently, **claims 12-16, 18-20, and 22-25** are pending.

Response to Arguments

2. Applicant's arguments with respect to independent **claims 12, 18-20, and 22** have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 12, 13, 15, and 18-20, and 22-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi *et al.* (U.S. Patent Number 6,374,291, cited in the Office action dated 7/15/03) in view of Okutomi *et al.* (U.S. Patent Number 6,211,972).

Regarding ***claims 12, 18, and 19***, Ishibashi discloses a communication apparatus (see Figs. 1 and 2), having a control method, and a computer-readable storage medium (ROM 6), which stores a program for controlling the communication apparatus (column 3, lines 46 through 54), capable of facsimile communication through the Internet by dial-up connection (see abstract,

and column 7, lines 11 through 25, being steps S9-S13 in Fig. 6), comprising means for establishing a dial-up connection from a station A to an Internet service provider to execute communication with a station B (see abstract, Fig 3, and column 7, lines 11 through 60, being steps S9-S13 in Fig. 6) having a TCP/IP address through the Internet (column 5, lines 28 through 60), and means for calling the station B from the station A, when the dial-up connection is established, notifying the station B via the PSTN (being inherent in the standard analog telephone lines L2, using a circuit switching method, as read in the abstract) that a facsimile has been sent through the Internet and description transmitted through the Internet (column 7, lines 34 through 55, see "(a) Third Party Table T1" in Fig. 3, and see Fig. 11), prior to station B accessing the Internet (see abstract and Fig. 11, and column 9, line 12 through column 10, line 14).

However, Ishibashi fails to teach of means for transmitting the facsimile information from the station A to the station B through a general public network without performing communication by the Internet communication by the Internet communication execution means and notification operation by the notification means, when the number of pages of the facsimile information to be transmitted fro station A to the station B through the Internet is not more than a predetermined value. Ishibashi discloses a communication apparatus (see Fig. 3), having a control method, and a computer-readable storage medium (ROM 2), which stores a program for controlling the communication apparatus (column 3, lines 6 through 11), capable of facsimile communication through the Internet (see Fig. 2), comprising means for establishing a connection from a station A to execute communication with a station B having a TCP/IP address (see Fig. 6) through the Internet (step S83 in Fig. 15, column 7, lines 38 through 47), and means for, when

the number of pages of the facsimile information to be transmitted from station A to the station B through the Internet is not more than a predetermined value (step S82 in Fig. 15, column 7, line 29 through column 8, line 4), transmitting the facsimile information from the station A to the station B through a general public network without performing communication by the Internet communication by the Internet communication execution means (step S84 in Fig. 15, and column 4, lines 1 through 12). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Okutomi in the system of Ishibashi, thereby transmitting the facsimile information from the station A to the station B through a general public network without performing communication by the Internet communication by the Internet communication execution means and notification operation by the notification means. Ishibashi's system would become more efficient with the teachings of Okutomi, since the data would be transmitted by facsimile if the number of pages doesn't exceed predetermined value, and transmitted through the Internet when the number of pages exceeds the predetermined value, as recognized by Okutomi, thereby reducing transmission delays over the public telephone network because of large multi-page documents.

Regarding ***claim 13***, Ishibashi and Okutomi disclose the apparatus discussed above in claim 12, and Ishibashi further teaches that the description information is summarized text representing a summary of facsimile communication (see Fig. 11).

Regarding ***claim 15***, Ishibashi and Okutomi disclose the apparatus discussed above in claim 12, and Ishibashi further teaches of transmitting a number of pages of facsimile information transmitted through the Internet and a communication time (see Fig. 11).

Regarding ***claim 20***, Ishibashi discloses a communication apparatus (see Figs. 1 and 2) comprising means for transmitting facsimile data via the Internet (see abstract, column 6, line 35 through column 7, line 25), and means for notifying a recipient, via the PSTN (see abstract, column 7, lines 26 through 55, and Fig. 11, being inherent in the standard analog telephone lines L2, using a circuit switching method, as read in the abstract), that the transmission means has already sent the facsimile data to the recipient via the Internet (column 7, lines 34 through 55, see "(a) Third Party Table T1" in Fig. 3, and see Fig. 11), prior to the recipient accessing the Internet (see abstract and Fig. 11, and column 9, line 12 through column 10, line 14).

However, Ishibashi fails to specifically teach of means for transmitting the facsimile data through a general public network without performing transmission by the transmission means and notification operation by the notification means when the number of pages of the facsimile data to be transmitted by the transmission means through the Internet is not more than a predetermined value. Okutomi discloses a communication apparatus (see Fig. 3) comprising means for transmitting facsimile data via the Internet (see Figs. 2 and 15, column 4, lines 1 through 12, and column 7, lines 38 through 47), and means for, when the number of pages of the facsimile data to be transmitted by the transmission means through the Internet is not more than a predetermined value (step S81 in Fig. 15, column 7, line 28 through column 8, line 4), transmitting the facsimile data through a general public network without performing transmission by the transmission means and notification operation by the notification means (step S84 in Fig. 15, column 7, lines 38 through 54). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Okutomi in the system of Ishibashi. Ishibashi's system would become more efficient with the

teachings of Okutomi, since the data would be transmitted by facsimile if the number of pages doesn't exceed predetermined value, and transmitted through the Internet when the number of pages exceeds the predetermined value, as recognized by Okutomi, thereby reducing transmission delays over the public telephone network because of large multi-page documents.

Regarding ***claim 22***, Ishibashi discloses a communication apparatus (see Figs. 1 and 2) comprising first means for sending facsimile data over a first communication network (being the Internet, see abstract) to a recipient (see abstract, and column 7, lines 11 through 19), second means for sending data over a second communication network (analog line L2) to the recipient (see abstract, column 7, lines 26 through 55, and Fig. 11), and third means (CPU 1) for controlling the first means and the second means (column 3, lines 29 through 33), wherein the third means controls the second means so as to send data (see Fig. 11) corresponding to the sending operation of the first means (see abstract, column 7, lines 26 through 55), and wherein the sending operation of the second means indicates that the first means has already sent the facsimile data over the first communication network to the recipient (column 7, lines 34 through 55, see "(a) Third Party Table T1" in Fig. 3, and see Fig. 11), prior to the recipient accessing the second communication network (see abstract and Fig. 11, and column 9, line 12 through column 10, line 14).

However, Ishibashi fails to specifically teach if the third means causes the first means not to send facsimile data over the first communication network to a recipient when the number of pages of the facsimile data to be transmitted by the first means through the Internet is not more than a predetermined value. Okutomi discloses a communication apparatus (see Fig. 3) comprising first means for sending facsimile data over a first communication network to a

recipient (see Figs. 2 and 15, column 4, lines 1 through 12, and column 7, lines 38 through 47), second means for sending data over a second communication network to the recipient (column 4, lines 1 through 12), and third means (CPU 1) for controlling the first means and the second means (column 3, lines 6 through 11), and wherein when the number of pages of the facsimile data to be transmitted by the first means through the Internet is not more than a predetermined value (step S81 in Fig. 15, column 7, line 28 through column 8, line 4), the third means causes the first means not to send facsimile data over the first communication network to a recipient (step S84 in Fig. 15, column 7, lines 38 through 54). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Okutomi in the system of Ishibashi. Ishibashi's system would become more efficient with the teachings of Okutomi, since the data would be transmitted by facsimile if the number of pages doesn't exceed predetermined value, and transmitted through the Internet when the number of pages exceeds the predetermined value, as recognized by Okutomi, thereby reducing transmission delays over the public telephone network because of large multi-page documents.

Regarding ***claim 23***, Ishibashi and Okutomi disclose the apparatus discussed above in claim 22, and Ishibashi further teaches that the first communication network (Internet) is a facsimile communication network (see abstract).

Regarding ***claim 24***, Ishibashi and Okutomi disclose the apparatus discussed above in claim 22, and Ishibashi further teaches that the second communication network is a telephone network (being inherent in the standard analog telephone lines L2, using a circuit switching method, as read in the abstract).

Regarding ***claim 25***, Ishibashi and Okutomi disclose the apparatus discussed above in claim 22, and Ishibashi further teaches that the data sent by the second means is a part of data sent by the first means (see Fig. 11).

5. **Claims 14 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi *et al.* (U.S. Patent Number 6,374,291, cited in the Office action dated 7/15/03) in view of Okutomi *et al.* (U.S. Patent Number 6,211,972), and further in view of Bobo, II (U.S. Patent Number 5,675,507, cited in the Office action dated 7/15/03).

Regarding ***claim 14***, Ishibashi and Okutomi disclose the apparatus discussed above in claim 12, but fail to specifically teach if the description information is information of a first page of facsimile information transmitted through the Internet. Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising means for performing dial-up connection from a station A (facsimile 24) to an Internet service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and means for, when communication by the communication execution means has been executed (process of Fig. 2), calling the station B (step 56, column 7, lines 6 through 8) to transmit information representing that facsimile communication has been executed and description information of the facsimile communication executed through the Internet (column 8, line 22 through column 9, line 37). Further, Bobo teaches that the description information is information of a first page of facsimile information transmitted through the Internet (column 9, lines 2 through 17). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bobo's teachings in the

system of Ishibashi and Okutomi. Ishibashi and Okutomi's system would become more user-friendly if adapted to incorporate Bobo's teachings, as the user would be able to quickly scroll through cover pages of transmitted messages, without downloading the entire message.

Regarding ***claim 16***, Ishibashi and Okutomi disclose the apparatus discussed above in claim 12, but fail to specifically teach of a means for selecting, as the description information to be transmitted, either summarized text representing a summary of facsimile communication or information of a first page of facsimile information transmitted through the Internet. Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising means for performing dial-up connection from a station A (facsimile 24) to an Internet service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and means for, when communication by the communication execution means has been executed (process of Fig. 2), calling the station B (step 56, column 7, lines 6 through 8) to transmit information representing that facsimile communication has been executed and description information of the facsimile communication executed through the Internet (column 8, line 22 through column 9, line 37). Further, Bobo teaches of a means for selecting, as the description information to be transmitted, either summarized text representing a summary of facsimile communication (column 8, lines 53 through 63) or information of a first page of facsimile information transmitted through the Internet (column 9, lines 2 through 30). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bobo's teachings in the system of Ishibashi and Okutomi. Ishibashi and Okutomi's system would become more user-

friendly if adapted to incorporate Bobo's teachings, as the user would be able to determine display options, without downloading the entire message.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp

EDWARD COLES
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